THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GIFTEC, LTD.

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Appeal No. 97-0052
Reexamination Proceeding 90/003,505[1]

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ON BRIEF

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Before CALVERT, *Administrative Patent Judge*, and McCANDLISH, *Senior Administrative Patent Judge*, and ABRAMS, *Administrative Patent Judge*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Request filed July 22, 1994, for the reexamination of Jack Hou, Patent No. RE 33,933, issued May 19, 1992, based on Application 07/378,401, filed July 11, 1989, for the reissue of Patent No. 4,708,689, issued November 24, 1997, based on Application 06/914,146, filed October 1, 1986.

This is an appeal from the decision of the examiner finally rejecting claims 3 through 8. Claims 1 and 2 have been allowed.

The appellant's invention is directed to a toy device. The subject matter before us on appeal is illustrated by reference to claim 3, which reads as follows:

3. A toy device adapted for movement comprising:

a) a music box movement supported on the toy device, the music box movement including a rotatable driving shaft having a protruding end, the music box movement comprising a power source for causing movement of the toy device;

b) a box located on the toy device and substantially enclosing the music box movement;

c) first guide means located on the box;

d) a rod extending non-rotatably from the first guide means for attachment of an element thereto;

e) a transmission system including a rotatable element secured to the protruding end of the driving shaft so as to rotate therewith;

f) a stub extending from the rotatable element so as to rotate therewith; and,

g) a reciprocating plate defining a follower surface in contact with the stub such that rotary motion of the rotatable driving shaft of the music box causes rotary motion of the rotatable element which, in turn, causes rectilinear reciprocating motion of the plate relative to the box, whereby such rectilinear motion of the plate imparts movement to the toy device.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

La Grove	143,082	Sep. 23, 1873
Chan (UK Patent Application)	2,117,258	Oct. 12, 1983
Reuge[2] (French Patent)	296,698	May 1, 1954

THE REJECTIONS

Claims 3 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chan in view of Reuge and La Grove.

Claims 3 through 8 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Reuge in view of Chan and La Grove.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

OPINION

Subsequent to the final rejection in this case, the appellant submitted a declaration directed to the commercial success allegedly enjoyed by the invention (Paper No. 10). The examiner refused to consider the declaration on the basis that the appellant had failed to show good and sufficient reasons why it was

[2] Translation Attached.

not earlier presented (Paper No. 12). The first issue argued by the appellant in the Brief is that the examiner erred in refusing to consider this declaration, to which the examiner replied in the Answer that such argument was not proper because the matter was petitionable to the Commissioner under 37 CFR § 1.181, rather than within the jurisdiction of the Board. We agree with the examiner and therefore will not consider this issue.

Both of the examiner's rejections are based upon 35 U.S.C. § 103. Our evaluation of the matter of the obviousness of the claimed invention in view of the prior art relied upon is based upon the following guidance from our reviewing court: The examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) and *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). This is not to say, however, that the claimed invention must expressly be suggested

in any one or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985) and *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom (see *In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

The examiner has rejected independent claim 3 as being unpatentable over the teachings of Chan in view of Reuge and La Grove. There is a great deal of commonality between the subject matter recited in claim 3 and the toy disclosed by Chan. Using the language of claim 3 as a guide, Chan clearly discloses a music box movement with a rotating shaft having a protruding end and a power source, a box substantially enclosing the music box movement, a transmission system including a rotatable element secured to the protruding end to rotate therewith, a stub

extending from the rotatable element, and a reciprocating plate defining a follower surface in contact with the stub so that rotary motion of the driving shaft of the music box causes rotary motion of the rotatable element which, in turn causes rectilinear reciprocating motion of the plate relative to the box, whereby the plate imparts movement to the toy.

Chan does not disclose the required "first guide means located on the box" or the "rod extending non-rotatably from the first guide means for attachment to an element thereto."[3]

[3] We note here that, although not commented upon by the examiner, the rod seems to serve no purpose in this claim, for although it is "for attachment of an element," such element is not claimed, nor is the rod connected to any other element recited in the claim.

The concept of driving multiple elements from a single music box movement in a toy is taught by Reuge. This reference discloses a spring motor 3 located in a box 1 within the structure of a doll toy. Through various gear trains, the spring motor drives a music device 6 and a pair of wheels 14 which cause the toy to rotate on a surface. By means of a cam 22 carried by one of the gears 17, the spring motor also motivates a lever 20 to reciprocate, which by way of a projection 22' on the lever causes the toy periodically to tilt (Figure 2). A rod 23 also is attached to reciprocating lever 20, and this allows the spring motor also to drive mechanism 24, 25 and 26, which causes the doll's arm to wave. Thus, Reuge would have taught one of ordinary skill in the art to use a single spring motor to: (1) operate a music device mounted in a toy; (2) rotate the toy; (3) tilt the toy; and (4) cause an additional element of the toy to move.

The appellant argues at several places in the Brief that the claim requires that the rod be "non-rotatable," which is not disclosed in the references. We do not agree. We observe here that the appellant's specification does not explicitly describe the rod as being non-rotatable, and that support for this limita-

tion is found only by interpreting the drawings, the appellant concluding that "it is impossible" for rod 60 to rotate in any fashion whatsoever about its longitudinal axis or about any axis other than the longitudinal axis (Brief, page 7). Such a rationalization also applies to rod 23 of Reuge for, like the appellant's specification, the text of Reuge does not specify whether rod 23 is rotatable or not. However, looking to the drawings, it would appear from Figures 1 and 2 that rod 23 is attached at its lower end to lever 20 by a pin and, since it must pull and push on a linkage at its other end, it is our view that one of ordinary skill would have concluded from this showing that rod 23 is not rotatable. This is confirmed by the fact that there appears to be no reason why rod 23 would need to be rotatable, and to make it rotatable would, in our view, complicate the construction for no discernible reason.

It is our opinion that one of ordinary skill in the art would have found it obvious from the teachings of Reuge to modify the Chan apparatus by attaching to member 13, which rocks the chair, a non-rotatable rod extending therefrom and movable therewith "for attachment of an element thereto." Suggestion for

such is found in the explicit teaching of Reuge to drive an element of the toy by connecting it by means of a rod to the reciprocating lever that tilts the toy, as well as the self-evident advantage of making the toy more attractive by providing movement to additional elements from the same power source, which would have been within the skill of the artisan.

Neither Chan nor Reuge, however, explicitly teach the required "first guide means located on the box," from which the rod that operates the additional element extends. However, in Reuge the dancing doll is "mounted on a box 1, which is attached to a base plate 2" (translation, page 1) and, as shown in Figures 1 and 2, it is apparent that the rod (23) passes through this box

in order to actuate the doll's arm, although the manner in which it does so is not shown in detail or described in the text. La Grove discloses a dancing toy figure in which the operating arm passes through the walls of the box upon which it is mounted, at which point it "slides through the guides i i" (column 2, lines 2 and 3). From our perspective, one of ordinary skill in the art therefore would have found it obvious to provide a guide means at the point at which the rod passed through the wall of the box, suggestion being found in the explicit teaching of La

Grove as well as the self-evident advantages of guiding a rod under such circumstances, which would have been known to the artisan.

For the reasons explained above, it is our view that the teachings of Chan in view of Reuge and La Grove establish a *prima facie* case of obviousness with regard to the subject matter of claim 3, and we therefore will sustain this rejection.

Independent claim 3 also stands rejected as being unpatentable over Reuge in view of Chan and La Grove. The only argument presented in rebuttal to this rejection is that the references "are all totally devoid of a rod 'non-rotatably' extending from the first guide means" (Brief, page 9). We have discussed the issues of the non-rotatable rod and the guide means above with regard to the other rejection, and our findings and conclusions

are equally applicable here. We therefore are of the opinion that this rejection also establishes a *prima facie* case of obviousness with regard to the subject matter of claim 3, and we will sustain it, also.

The extent of the appellant's arguments regarding the patentability of dependent claims 4 through 8 for either of the rejections was limited to the bare recitation of the structure

each adds to the claim from which it depends (Brief, pages 12 and 13). Since the appellant has chosen not to challenge with any reasonable specificity before this Board the rejection of any of the dependent claims, they will be grouped with the independent claim from which they depend, and will fall therewith. See *In re Nielson*, 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1526

knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). We believe that to be the case here.

Both of the examiner's rejections are sustained.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT Administrative Patent Judge	)
HARRISON E. McCANDLISH, Senior Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND
NEAL E. ABRAMS Administrative Patent Judge	) INTERFERENCES

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